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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/812,127	03/29/2004	Beat Heer	A01511	2184

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ROHM AND HAAS COMPANY
PATENT DEPARTMENT
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EXAMINER

NEPVEUX, FELIX JOSEPH

ART UNIT PAPER NUMBER

1617

DATE MAILED: 08/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/812,127	HEER ET AL.	
	Examiner	Art Unit	
	Felix J. Nepveux	1617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>6/24/04; 8/16/04</u> and <u>1/03/05</u> | 6) <input type="checkbox"/> Other: ____ |

5.0-2

DETAILED ACTION

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-8 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 10811518. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are overlapping in scope. The composition of Application No. 1081518 comprises (a) at least one sulfur-containing s-triazine; (b) at least one pyrithione compound;

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and (c) at least one additional microbicide selected from 2-alkyl-4-isothiazolin-3-ones and halopropynyl carbamates, while the composition of the instant application comprises (a) at least one sulfur-containing s-triazine; and (b) at least one pyrrithione compound. Therefore, the composition of the instant application is broader in scope than application No. 10811518 and the said claims are not patentably distinct.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by Wolfgang et al. (EP 0979033 B1).

Wolfgang et al. teaches a bactericidal composition that **1)** comprises 10.0% zinc pyrrithione, **2)** comprises 4.38% 2-methylthio-tert-butylamino-6-cyclopropylamino-s-triazine (Irgarol 1051), **3)** has no halogenated biocides, **4)** has no methyl-N-benzimidazol-2-yl carbamate, and **5)** is useful for the preservation of paints. Wolfgang et al. also specifies that **N²-tert-butyl-N⁴-ethyl-**

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6-methylthio-1,3,5-triazine-2,4,-diamine is one of the preferred s-triazine compounds for microbicidal compositions (See page 6, section [0040], example VIII; and page 3, section [0022], for example).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wolfgang et al. (EP 0979033 B1) as applied to claims 1-3, in view of Otsu et al (US 5,696,169).

Wolfgang et al. teaches a bactericidal composition that **1)** comprises 10.0% zinc pyrithione, **2)** comprises 4.38% 2-methylthio-tert-butylamino-6-cyclopropylamino-s-triazine (Irgarol 1051), **3)** has no halogenated biocides, **4)** has no methyl-N-benzimidazol-2-yl carbamate, and **5)** is useful for the preservation of paints. Wolfgang et al. also specifies that **N²-tert-butyl-N⁴-ethyl-6-methylthio-1,3,5-triazine-2,4,-diamine** is one of the preferred s-triazine compounds for microbicidal compositions (See page 6, section [0040], example VIII; and page 3, section [0022], for example).

Wolfgang et al. does not teach a microbicidal composition comprising **zinc oxide in an amount from 2% to 12%**.

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Otsu et al (US 5,696,169) teaches that zinc oxide is known to improve the antibacterial activity of hinokitiol (See column 1, lines 60-63, for example). Otsu also teaches a cosmetic composition comprising hinokitiol and 10% zinc oxide (column 10/11, Production Example 8, for example).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to add zinc oxide in the claimed percentages to Wolfgang's microbicidal composition comprising 10.0% zinc pyrithione and 4.38% 2-methylthio-tert-butylamino-6-cyclopropylamino-s-triazine (Irgarol 1051).

One of ordinary skill in the art would have been motivated to **add zinc oxide** in the claimed percentages to Wolfgang's microbicidal composition because Wolfgang et al. teaches a microbicidal composition comprising 4.38% 2-methylthio-tert-butylamino-6-cyclopropylamino-s-triazine (Irgarol 1051) and 10.0% zinc pyrithione (See page 6, section [0040], example VIII), and Otsu et al (US 5,696,169) teaches that 10% zinc oxide is known to improve the antibacterial activity of hinokitiol in a cosmetic composition (See column 1, lines 60-63; column 8, lines 30-32; and column 10/11, Production Example 8, for example) Therefore adding zinc oxide in the instant claimed percentages to Wolfgang's composition would have been reasonably expected to be effective for enhancing the microbicidal activity.

Conclusion

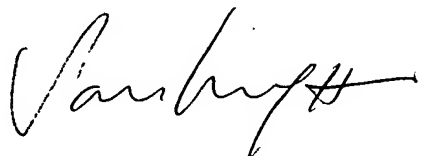
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Felix J. Nepveux whose telephone number is (571) 272-8514. The examiner can normally be reached on m-f 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on (571) 272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Felix J. Nepveux V



SAN-MING HUI
PRIMARY EXAMINER